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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,913	08/27/2001	Roy M. Griswold	60SI01998	4055

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10/07/2002

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 10/07/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

mk-3

Office Action Summary

Application No.

09/939,913

Applicant(s)

GRISWOLD ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 18 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

The post office address of all the inventors has been omitted.

Specification

2. The disclosure is objected to because of the following informalities: in the specification on pages 6, 9, and 10, in the formulae for silanes $R^E_h(\text{SiOR}^A)_{3-h}$ and $R^V_i(\text{SiOR}^B)_{3-i}$ are incomplete. Applicant sets forth that h and i vary from 1 to 3. This results in an open valency on the silicon atom on both silanes since the amount of groups around the silicon amounts to three, where silicon requires the presence of four groups.

Appropriate correction is required.

Double Patenting

3. Applicant is advised that should claim 11 be found allowable, claim 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both

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cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The only difference between claims 11 and 19 is the use of the word "paper" before release in the preamble of the claim 19. The rest of the claims are identical. Since the components of the composition are the same in both claims, it is the examiner's position that there is no structural difference between the compositions of claims 11 and 19.

Claim Objections

4. Claims 18 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 18 depends indirectly from claim 10, which already sets forth that the composition is in the form of an aqueous emulsion.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For claims 1, 11, and 19, and 22, applicant sets forth formulae for silanes $R_h^E(\text{SiOR}^A)_{3-h}$ and $R_i^V(\text{SiOR}^B)_{3-i}$. Applicant sets forth that h and i vary from 1 to 3. This results in an open valency on the silicon atom on both silanes since the amount of groups around the silicon amounts to three, where silicon requires the presence of four groups. Thus, it is not known how the last valency of silicon is filled. Claims 2-10, 12-18, and 20-24 are rejected because they depend either directly or indirectly from claims 1, 11, or 19. See paragraph 2 above.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6, 8, 9, 10, 12, 14, 16, 18, and 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 6 and 14, there is a lack of antecedent basis for R' since no R' is set forth in claims 12, 10, 8, 6, 4, or 1. There is an R' set forth in claim 2.

For claims 12 and 20, there is no hydrogen siloxane set forth in claims 18, 16, 14, 12, 10, 8, 6, 4, or 1.

In addition, claim 10, from which claims 12, 14, and 16 depend, claims an aqueous emulsion, where claims 12, 14, and 16 set forth a composition. The same problem occurs for claim 20, which depends from claim 18.

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Allowable Subject Matter

9. Claims 1-5, 7, 11, 13, 15, 17, 19, and 21-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

10. Claims 6, 8, 9, 10, 12, 14, and 16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action.

11. Claims 18 and 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, and the claim objections set forth in this Office action.

12. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art is Mushelewicz et al. (U.S. Patent No. 6,020,412) and Lehman et al. (U.S. Patent No. 5,733,698). Both of these patents teach release compositions that contain epoxysilane anchoring agents. Neither of these patents teach or suggest a reaction product of an epoxysilane and an unsaturated silane obtained using a condensation catalyst in the presence of water.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jackel et al. (U.S. Patent No. 4,336,309), Mogami et al. (U.S. Patent No. 4,556,605), and Murakami et al. (U.S. Patent No. 5,246,995) are being cited for teaching products or vinylsilanes and epoxysilanes as coatings. Morita et al. (U.S.

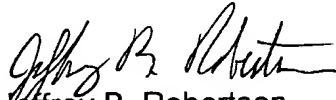
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Patent No. 4,742,103), O'Brien et al. (U.S. Patent No. 5,616,672), O'Brien et al. (U.S. Patent No. 5,932,060) and Griswold et al. (U.S. Patent No. 6,077,611) are being cited for generally teaching release compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeffrey B. Robertson
Examiner
Art Unit 1712

JBR 

October 1, 2002